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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,867	09/16/2003	Takayuki Kawabe	1990.68360	3124

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EXAMINER	
ORTIZ CRIADO, JORGE L	

ART UNIT	PAPER NUMBER
2627	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/663,867	**Applicant(s)** KAWABE, TAKAYUKI	
	Examiner Jorge L. Ortiz-Criado	**Art Unit** 2627	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached document.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

ANDREA WELLINGTON
SUPERVISORY PATENT EXAMINER

Response to Arguments

Applicant's arguments filed 11/13/2006 have been fully considered but they are not persuasive.

Response of Rejections under 35 USC § 112

Applicant argues that the examiner appear to reject claims 3 and 7, however, claim 3 was previously canceled, therefore the outstanding office action must be vacated.

Claim 3 was inadvertently added from the previous Non-Final action mailed 2/08/2006, because claim 3 included the subject matter rejected under the same headings section of 112 first paragraph. Under the ground of rejection of the Final office action mailed 08/07/2006 "Claims 1, 6 and 7 are rejected under 35 U.S.C. 112, first paragraph, ground section headings. It is clear that the rejection was meant to be to claims 1,6 and 7, which includes the same subject matter previously presented in claim 3. Hence, the outstanding office is not vacated, because it is clearly stated under the ground sections headings, which claims were rejected.

Applicants argues that the examiner does not assert what undue experimentation he personally believes would have to be performed.

The rejection is made as follows: The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims recites the limitation wherein the position trajectory output from the trajectory generating unit is defined a function of third order or higher with respect to time. The disclosure does not enable one skilled in the art to make and use the invention as claimed without undue experimentation, for the higher order function. Applicant's description of functions experimented, performed and/or described in the specification does not contain in any sense any description of functions experimented or performed with a higher order. It means, as above, that there is absolutely no described portion in the specification that shows any function of higher order.

Applicant argues that the Specification describes a number of specific formulae on pages 25-27, and several functions of orders higher than the third.

The examiner respectfully disagrees and cannot concur with the Applicant, because the examiner cannot find from the first page until the last page of the specification and or drawings, which are part of the disclosure, a single function of order higher than the third. It is respectfully requested to the Applicant to cite a specific line and page where such function appears, because as far as the examiner can tell, the cited pages by the Applicant only contains functions not higher than the third order.

Response of rejection under 35 USC § 102

Applicant argues that Watanabe reference was "not relied upon" and that Watanabe reference was used to reject claims 1 and 6-7 and that the office action must be vacated.

The examiner cannot concur with the Applicant because under the section heading the Watanabe reference was clearly and specifically relied upon as cited in the office action, "Claims 1, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al. J.P. 04-028020". Applicant also can note that the Watanabe reference was cited in the precious Non-Final action mailed 2/08/2006 and was inadvertently cited again. Hence, the outstanding office is not vacated, because it is clearly stated under the ground sections headings, how the claims were rejected.

Applicant argues that Watanabe does not discloses disclose or suggest a function of third order or higher with respect to time.

The examiner cannot concur because Watanabe clearly specifies adjusting with the cubic function (third order function) the state of focusing system due to change of lapse of TIME. Hence, Watanabe does discloses a function of third order or higher with respect to time, as claimed.

Response of rejection under 35 USC § 103

Applicant argues that the examiner demonstrated an impermissible use of hindsight to justify his rationale for modifying Tanaka. Applicant argues that the examiner rationale for making the proposed modification is also based on clear misinterpretation of the present specification. And that no teachings or suggestion has even cited from the prior art to support the examiner's assertion of what was "art-recognized equivalents" at the time of the invention.

The examiner cannot concur with the Applicant because first in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Tanaka discloses that the position trajectory output from the trajectory-generating unit is defined by a trigonometric function.

Applicant in his own words has recognized such equivalences and obvious modifications, see page 29, lines 13-18, "*the focus search control is conducted by a cubic function with respect to time until the shift to the control at a constant velocity. However, the function may be of, for example, fourth-order or higher and a combination trigonometric functions may be used as the function. Otherwise,* ***any function may be used as far as the second order differential of it is a continuous function***".

The second order differential of Takada is a continuous function at the time of the invention, one of ordinary skill in the art would have understood to substitute Takada's trigonometric functions by a function of third order or higher because would perform equally as well.

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